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SIEMENS CORPORATION
INTELLECTUAL PROPERTY LAW
DEPARTMENT
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

In re Application of

Vanderveen, et al.

Application No. 10/638,219

Filed: August 8, 2003

Attorney Docket No.
2002P13157US01; 60,427-60

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed October 17, 2005, to revive the above-identified application. This also a decision on the petition under 37 CFR 1.137(b), filed October 17, 2005, which was filed in the alternative.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the final Office action mailed February 23, 2005, which set a shortened statutory period for reply of three (3) months. A response was filed on April 20, 2005, which failed to place the application in condition for allowance. An Advisory Action informing applicant of the same was mailed on August 22, 2005. A proper response to the final Office action was not received within the allowed period, and the application became abandoned on May 24, 2005. A Notice of Abandonment was mailed on September 23, 2005.

TREATMENT UNDER 37 CFR 1.137(a)

A grantable petition under 37 CFR 1.137(a)[1] must be accompanied by: (1) the required reply,[2] unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

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[1] As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

[2] In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

The instant petition lacks item (3).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."[3]

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."[4]

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"[5]
"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."[6]

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."[7]
The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"[8] Nonawarness of a PTO rule will not constitute unavoidable delay.[9]

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[3]Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

[4]Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

[5]Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

[6]Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

[7]Id.

[8]See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

[9]See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a

Application of the standard to the current facts and circumstances

Petitioner maintains that the abandonment of this application was unavoidable because the examiner assigned this application did not make a timely determination of whether the amendment after final filed April 20, 2005, placed the application in condition for allowance.

With regard to item (3) above, the aforementioned argument that the above-cited application was unavoidably abandoned has been considered, but does not establish that the abandonment of the application was unavoidable. Applicant ultimately bears the responsibility for filing a proper response to the final Office action before the expiration of the statutory period for reply, notwithstanding the Office's apparent delay in considering the amendment. Certainly, the delay in the Office 's consideration of the amendment is regrettable, however; this delay did not relieve petitioner of the responsibility of filing a proper reply to the Final Office action within the allowed statutory period, whether that response be in the form of a Notice of Appeal, amendment and/or a Request for Continued Examination. Further, the delay in filing a proper response to the final Office action cannot be considered unavoidable because petitioner always had the option of filing a Request for Continued Examination to be considered in the alternative if the amendment filed April 20, 2005, failed to place the application in condition for allowance. The petition under 37 CFR 1.137(a), is therefore, dismissed.

Deposit account 50-1482 will be charged $500.00 for the petition fee.

TREAMENT UNDER 37 CFR 1.137(b).

Petitioner has established that the delay in filing a proper response to the final Office action was unintentional. Examiner Katrina Harris has determined that the amendment filed October 17, 2005, places the application in condition for allowance. The petition under 37 CFR 1.137(b) is granted, accordingly.

Deposit account 50-1482 will be charged $1,500.00 for the petition fee.

The address as cited on the petition differs from the address of record. Although a courtesy copy of this decision is being mailed to the address as cited on the petition, all future correspondence will be mailed solely to the address of record until appropriate written instructions to the contrary are received.

The application file is being forwarded to Technology Center 3700, GAU 3747 for further processing.

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different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

Telephone inquiries concerning this decision should be directed to the undersigned (571) 272-3222.

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